

Application No.: 09/736,232

Docket No.: 65856-0025

AMENDMENTS TO THE DRAWINGS

The attached sheet(s) of drawings includes changes to FIG. 10.

Attachment: Replacement sheet

Annotated sheet showing changes

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REMARKS

Applicant has carefully reviewed the Office Action mailed October 01, 2004, and thanks Examiner Day for the detailed review of the pending claims. In response to the Office Action, claim 1 has been amended. By way of this amendment, no new matter has been added. Accordingly, claims 1-16 remain pending in this application. Applicant respectfully requests reconsideration of the present application in view of the following remarks.

Drawings

Applicant notes that paragraph [0031] has been amended to correct the reference numeral to the "Select Dialog" screen 50. FIG. 10 has been revised to include reference numeral 23.

Specification

Applicant notes that paragraph [0004] has been amended to delete the redundant 'can.' Applicant also notes that paragraph [0056] has been amended to delete the redundant 'The "Corrective Mode".'

Claim Rejections – 35 U.S.C. § 112

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. Applicant notes that independent method claim 1 has been amended to clarify to the Examiner that claim 1 was *never* a means plus function claim. The Examiner cites MPEP §2164.08(a) and *In re Hyatt* in rejecting claim 1 as a "single means claim." Applicant notes that *In re Hyatt* defines a single means claim as "a claim drafted in 'means plus function' format yet reciting only a single element instead of a combination."

Claim 1 is further rejected under 35 U.S.C. § 112, second paragraph as being incomplete. Applicant notes that the claims, viewed as a whole, limit the claimed method sufficiently to provide notice of the claimed invention to one skilled in the art as to how the limitation of claim 1 is a step in the claimed method. The Examiner is respectfully requested to

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cite the precedent for such a rejection. The Examiner has quoted a portion of § 112, second paragraph requiring that the specification conclude with one or more claims to particularly point out the invention. Applicant submits that the claims meet the quoted requirement, and is unaware of any requirement that *each* claim particularly point out the invention.

Claim Rejections – 35 U.S.C. § 103

Claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eaton Corporation “Eaton Truck Components Bulletin, TRIB-9701”, 1997, (hereinafter Eaton), in view of *Kumra et al.*, U.S. Patent 6,077,302, (hereinafter Kumra).

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness as follows: “To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. A case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (CAFC, 1966). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

No Motivation for Claims 1-11

Applicant respectfully traverses the 103(a) rejections to independent claims 1 and 7 because there is no suggestion, motivation, or objective reason to combine the cited references. “If identification of each claimed element in the prior art were sufficient to negate patentability,

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very few patents would ever issue." *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998). "Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability'." *Id.* quoting *Sensonics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

In re Oetiker further provides that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." "The examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 USPQ2d 1453, at 1458 (Fed. Cir. 1998). Applicants cannot find this motivation in either Eaton or Kumra. In addition, the Examiner is respectfully requested to provide the motivation to combine Eaton and Kumra.

At the outset, Applicant agrees with Examiner that Eaton does not disclose a graphical user interface (GUI) program, and notes that Eaton does not provide any motivation for using a GUI, as positively recited in independent claims 1 and 7. Kumra, similarly, does not provide any references to using a GUI to enter measurements of a vehicle driveline configuration, nor does Kumra provide any motivation to use a GUI to enter measurements of a vehicle driveline configuration. In contrast, paragraph [0036] teaches a "main "Driveline Angle Analyzer" screen 70 that allows the user to enter vehicle information, as shown in Fig. 7."

Kumra discloses a vibration analysis technique used to design vibration isolators for a vehicle 20. Kumra describes the vehicle 20 as including an engine 24, transmission 26, exhaust system 28, and axles 30. Column 4, lines 20-24. Kumra further identifies sources of vibrations as being external such as the road, or internal, such as the engine 24, transmission 26, and exhaust system 28. Column 4, lines 30-33, and column 7, lines 14-19. Kumra identifies a method for determining the excited frequencies in the structure of the vehicle generated by these sources. In contrast, independent claims 1 and 7 recite "entering measurements for the vehicle driveline configuration." These measurements are used to calculate parameters such as torsional

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acceleration and inertia. Therefore, Kumra does not teach, suggest or show any analysis on the driveline configuration of a vehicle as positively recited in the rejected claims.

Dependent claims 2-6 and 8-11 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. As an example, claim 6 recites "saving results from the determination of one of the torsional acceleration and the inertia for the vehicle driveline configuration as an image file." These teachings are not taught in the prior art of record. Accordingly, Applicant respectfully requests withdrawal of the rejections to claims 1-11.

References do not Teach all Elements of Claims 12-16

The prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claim 12 positively recites "displaying one of the torsional acceleration and the driveline inertia of the selected driveline configuration." Applicants note that neither Eaton nor Kumra teach this limitation. Specifically, Eaton does not teach displaying the torsional acceleration or the driveline inertia, but teaches notifying the user when the torsional acceleration is within one of three selected ranges. Applicants respectfully point to FIG. 18 of the present application where a torsional acceleration of 1086.55 rad/s² and a coast inertia of 56.93 ft-lbs are displayed on screen 180. In contrast, the worksheet of the Eaton Bulletin does not mention displaying total driveline torsional acceleration or inertia.

Kumra does not teach, suggest or show "displaying one of the torsional acceleration and the driveline inertia of the selected driveline configuration." As noted above, Kumra does not disclose calculations of the torsional acceleration of the driveline, furthermore, Kumra does not disclose display of torsional acceleration or inertia.

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Dependent claims 13-16 teach independently patentable subject matter, although they are also patentable merely by being dependent on claim 12. As an example, claim 14 recites "printing a worksheet to aide a user in entering of the measurements for the selected vehicle driveline configuration." This limitation is not taught in the prior art of record. Applicants respectfully request withdrawal of the rejections to claims 12-16.

Conclusion

In view of the above remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65856-0025 from which the undersigned is authorized to draw.

Dated: January 3, 2005

Respectfully submitted,

By Kenneth W. Jarrell

Michael B. Stewart

Registration No.: 36,018

Kenneth W. Jarrell

Registration No.: 52,484

RADER, FISHMAN & GRAUER PLLC

39533 Woodward Avenue

Suite 140

Bloomfield Hills, Michigan 48304

(248) 593-3310

Attorneys for Applicant

Attachments

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